REMARKS

The examiner considers claims original claims 29-44 (of which pending claims 52-70 are based upon) to belong to the same invention since he grouped them as Group IX in the first restriction requirement. As such, there must have been some semblance of unity when the examiner first examined the claims. If there was an error in the first Office Action, then a revised first Office Action should have been issued instead of a second Office Action. Such piecemeal examination clearly delays the prosecution of the application and increases the costs incurred by our client. It also deprives the applicant the benefit of responding to a further action before the final action issues. The examiner has now further split up Group X into six different groups and requiring a further restriction to the same group (Group X) which he had originally determined to belong to a single group of invention.

In order to properly restrict between patentably distinct inventions, the Examiner must show:

(1) the inventions are independent or distinct as claimed; and

(2) there would be a serious burden on the Examiner if restriction is not required. MPEP § 803.

Moreover, restriction is only proper when there is no chance that "MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION." MPEP § 803.01.

Distinct Inventions

To show independent inventions, the Examiner must show that the inventions are related, but not distinct as claimed. MPEP § 806. Here, the examiner cites multiple utilities of the same compound: to control entry into a cell, to treat infection in vertebrates, and to induce immunity. However, the Examiner fails to indicate where the distinction lies, except for a general statement citing distinct physical, chemical, and functional properties. Nevertheless, the Examiner does not recognize that all the claims relate to a genus of agents. Presumably, the claims in the instant restriction requirement were originally groups within a single grouping for this reason.

The Applicants elected Group X from the restriction requirement dated Sept. 21, 2005. According to the restriction requirement, the Application elected claims "drawn to a method for controlling entry of a flavivirus into a cell using a sequence substantially homologous to SEQ ID 21, a pharmaceutical composition, a method for inducing immunity, and a vaccine **classified in class 930, subclass 10.**" Once, elected however, the Examiner now cites additional

classifications, **none of which corresponds to class 930, subclass 10.** Rather, the Examiner has cited new classes for exactly same subject matter, suggesting that reliance on the Examiner's classification is arbitrary, rather than being grounded upon the principles preventing multiple patents for the same subject matter.

Moreover, the Applicant points out that in the response to the original restriction requirements, the independent claims belonging to class 930, subclass 10 remained unchanged. The applicant introduced new dependent claims only to maintain the spirit of the invention of Group X in accordance with the relevant sequence ID's in all but a single case.

In any event, the Applicant believes that the examiner's objection is based upon a misunderstanding of the claimed invention. The feature in common between independent claims 52, 55, 62, 66 and 70 is an agent that functionally interferes with the domain III of the flavivirus envelope protein. The examiner has not cited any prior art documents that impact on the patentability of this inventive feature. As such, in the absence of any known prior art document, we believe this single general inventive concept, or common feature, forms a relationship between the independent claims in the different categories.

Significantly, the examiner provides no support for his assertion that claims are distinct and independent.

Claim 52 is directed to a method for controlling entry of a flavivirus into a cell by administering to the cell the agent.

Claim 55 is directed to a method for treating a flavivirus infection in a cell by administering to the cell the agent.

Claim 62 is directed to a pharmaceutical composition for treating a flavivirus infection, the composition comprising the agent and a pharmaceutically acceptable carrier.

Claim 66 is directed to a method for inducing immunity to a flavivurs in a cell by administering to the cell the agent.

Claim 70 is directed to a vaccine for a flavivirus, the vaccine comprising the agent.

The examiner will note that the above independent claims all relate to different embodiments of the single invention, which is administering to the cell an agent that functionally interferes with the domain III of the flavivirus envelope protein. The examiner requires that if Group II or III is elected, then a further election of one of the species (*i.e.* the antibody or competitive ligand) must be elected. However, dependent claims 57, 58, 63 and 64 only further

limit the invention to specific embodiments and their features do not relate to another independent and distinct invention. Further, the different embodiments, or alternatives, are of a similar nature, *i.e.* they functionally interfere with the domain III of the flavivirus envelope protein.

For the above reasons, we believe that pending claims 52-70 relate to a single distinct and independent invention. Hence, the examiner's restriction requirement should be withdrawn.

Burden on Examiner

The Examiner is justified in a restriction requirement where the claims are related to separate patent classifications. MPEP § 808.02. In the original office action, the Examiner cited the subject matter of the current restriction requirement to be the same classification, presumably requiring a single search with respect to the agent of the current claims. The Examiner is appears to be attempting to find reasons for restricting the current claims by citing new patent classifications, causing the Applicant undue hardship and costs in prosecuting the current application. The Examiner will note that the agent of the present disclosure will require only a single search. Moreover, the agent will note that the restriction the subject matter of the present application as it now stands, the applicant will be in a position to file for patent applications on the withdrawn claims, thereby **obtaining multiple patents on exactly the same subject matter.**

For the foregoing reasons, the restriction requirement should be withdrawn.

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to Deposit Account Number **50-2638**. Please ensure that Attorney Docket Number 59419-010102 is referred to when charging any payments or credits for this case.

Respectfully submitted,

Date: 20 April 2006

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